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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Thomas L. Irving
FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/987,427 | FERRARI ET AL. | |
| Period for Reply | Examiner | Art Unit | |
| | Alycia Berman | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 May 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 36-74 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 36-74 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Receipt is acknowledged of the priority papers filed January 17, 2002 and the preliminary amendment filed May 29, 2002. Claims 1-35 have been cancelled. Claims 36-74 have been added and are pending.

Election/Restrictions

Upon further review of the claims and the prior art, the telephone restriction requirement made on November 13, 2002 has been withdrawn. All the claims have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 36-42 and 44-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,945,095 (095)

US '095 discloses cosmetic compositions that contain pulverulent compounds and a dispersion of surface-stabilized polymer particles in a liquid fatty phase (col. 2, lines 63-67). For film-forming polymers see column 4, lines 14-15. For free-radical polymers, polycondensates and polymers of natural origin see column 4, lines 8-10. For acrylic and vinyl polymers see column 4, lines 43-52. For constituents of the liquid fatty phase that meet the instant claims see column 4, line 53 to column 5, line 23. For non-volatile and volatile polydimethylsiloxanes, phenylated silicone oils and substituted or unsubstituted silicone oils see column 5, lines 13-22. For surface stabilizing sequential, graft and random polymers see column 6, lines 56-59. For the surface stabilizing polymers of instant claims 54 and 55 see column 7, line 13 to column 8, line 33. For an additional fatty phase see column 8, line 48 to column 9, line 22. For the products of instant claims 60-63 see column 10, lines 25-63.

See the examples beginning with Example 7 at column 12 for the method of making a composition by mixing black iron oxide pigment with paraffin wax and lanolin alcohol and then mixing this with a mixture of the polymeric dispersion and fillers and a method of applying the composition to the skin or lips. Example 7 contains about 34 wt% of a colloidal dispersion (Phase A). The examples also teach a little over 1 wt.% polymer particles based on the total weight of the compositions.

The preambles of the claims directed to such things as making up or caring for the skin or lips, limiting the migration of makeup, increasing the stability of makeup, etc.

are not given patentable weight over the prior art compositions used or made in the same manner instantly claimed. The prior art teaches making compositions containing the same components as instantly claimed and applying those compositions to the skin and/or lips. One of ordinary skill in the art would expect the prior art compositions containing the same components as instantly claimed to exhibit the same properties absent evidence to the contrary. . *In re Tuominen*, 213 USPQ 89, *In re Pearson*, 181 USPQ 641.

US '095 does not explicitly disclose that the pigment and filler particles are provided in a colloidal dispersion, stabilizing the particles in the colloidal dispersion with a dispersant, the amount of dispersant in relation to the total surface area of the particles in the colloidal dispersion or 2-60 wt% or 4-25 wt.% polymer particles based on the total weight of the composition.

The pigment and filler particles are mixed with liquid fatty substances and then mixed with other constituents to form a composition. It is known in the art to use particles in micrometer size in order to obtain more even dispersion and more stable compositions, for example. Therefore, it is considered within the skill in the art to use pigment and filler particles in micrometer size in the dispersions thereby obtaining a colloidal dispersions of the pigment and/or filler particles. One of ordinary skill in the art would expect the mixture of pigment and filler particles as taught in the examples of US '095 to be in the form of a colloidal dispersion absent evidence to the contrary.

The amounts of components in the composition are not considered critical to the invention absent evidence of unexpected results. It is within the skill in the art to select

optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). It would have been obvious for one skilled in the art to vary the proportions of components in a composition to arrive at the best compositions for the intended purpose. "It is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '095 optimizing the parameters of the components of the composition and adding a surfactant (dispersant) with the reasonable expectation of obtaining a composition with good cosmetic properties

Claims 36-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,945,095 (095) in view of the CAPLUS abstract of DE 19643062 A1 (062).

US '095 teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not explicitly disclose a colloidal dispersion of particles stabilized with a dispersant.

DE '062 teaches that pigment dispersions in an oil phase are stabilized with Applicant's preferred dispersants, poly-12-hydroxystearates for use in cosmetics.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '095 using stabilized pigment dispersions as

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taught by DE '062 expecting to obtain cosmetic compositions without pigment sedimentation.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
November 15, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200